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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,442	03/12/2004	Rainer Muller	5725.0864-01	5278

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/798,442	Applicant(s) MULLER ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-23 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on 12/8/05. Due to an inadvertent typographical error, claims 39-40 were not included in the office action. This error is regretted. Claims 19-23, and 31-40 are pending in the application and the status of the application is as follows:

The following new grounds of rejection are necessitated by the amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19-23, and 31-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

- a. To overcome the art rejection applicant added the limitation “ liquid” before detergent and conditioning cosmetic hair compositions and point out support for the expression at page 4, lines 1-14. At page 4, lines 1-4 the specification states:

“Thus, a subject of the present invention is novel detergent and conditioning cosmetic hair compositions, characterized in that they comprise, in a cosmetically acceptable aqueous medium, (A) a washing”

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Therefore the support at page 4, lines 1-4 are for cosmetically aqueous medium. There is no support for the claim that is amended drawn to

(Currently Amended) A liquid detergent and conditioning cosmetic hair composition comprising, in a cosmetically acceptable aqueous medium:

(A) a washing base and

(B) at least one liquid ester chosen from esters of formula (1):

R_1COOR_2 (1)

Wherein... groups.

Applicants also point out support at page 12, lines 5-10. The specification at page 12, lines 5-10 states:

“The cosmetically acceptable aqueous medium may consist solely of water or of a mixture of water and a cosmetically acceptable solvent such as a C1-C4 lower alcohol, for instance ethanol, isopropanol, tert-butanol or n-butanol; alkylene glycols, for instance propylene glycol, or glycol ethers. The detergent compositions according to the”

Therefore the support is for describing the aqueous medium and not for the concept that the composition, which has both the detergent and liquid ester, is a liquid...hair composition.

Applicants also point out support at page 15, lines 18-20. The specification at page 15, lines 18-20 states:

These compositions can be in the form of more or less thickened liquids, creams or gels and are mainly suitable for washing and caring for the hair.

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There is no support for liquid. The support is for “ more or less thickened liquids”.

Thickened liquids are viscous. The specification does not define the meaning for “ more or less”.

Liquids are not same as thickened liquids. Both have different viscosities.

Applicants also point out support at page 16, example drawn to shampoo compositions.

Shampoo can be liquid or thickened liquid or it can be in the form of gel or it can be in the form of cream.

Therefore the amendment drawn to “ liquid” is new matter for the reasons stated above.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 19-23 and 31-38 are, rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,013,763 ('763).

Claim construction

There is no support in the specification for the expression “ liquid”. There is support in the specification for “thickened liquid”. Lotion disclosed in the abstract of the patent reads on “ thickened liquid”.

See table I example II. Cetereath 20 reads on the claimed detergent base or claimed nonionic surfactants of claim 38. Quaternium –18 also reads on the claimed detergent base or cationic surfactants of claim 33. Isostearyl neopentanoate reads on the claimed liquid ester, where in R1 is branched C3-C5 hydrocarbon based groups of claim 19 or branched C3-C5 branched

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alkyl group of claim 20 or R1 is tertiary butyl group of claim 23. The compound reads on R2 where in R2 is linear C12-C26 hydrocarbon based groups of claim 19 or linear C1-C26 alkyl of claim 20 or R2 is isostearyl of claim 23. Polyquaternium reads on claimed adjuvant, which is cationic polymer or cationic polymer of claim 34, which is “ quaternary cellulose derivatives”.

Claim Rejections - 35 USC § 103

5. Claims 19-23, and 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents ‘763 and 6,143,286 (‘286).

The instant application is claiming a detergent and conditioning cosmetic hair composition comprising:

- 1. A washing base (surfactant)*
- 2. Liquid esters of formula I (species are claimed in claims 22-23)*
- 3. Adjuvant (cationic polymers of claims 34-35)*

Patent ‘763 as applied above. Patent does not teach the limitation of claims 39-40 drawn to compositions wherein the concentration of the surfactant is between 4-50%. Patent teaches concentration of the surfactant as 1%. However patent '286 teaches compositions for hair using 1-3. See col.16, line 10 for the range of the detergent base which is same as surfactant, see col.16, lines 15 et seq, col.16, and col.17, lines 1-27. See col.14, lines 29-30 for the range, which overlaps with the claimed liquid ester range, see col.14, lines 42 and 43 for the two species which are “ isostearyl neopentanoate and tridecyl neopentanoate” which reads on the claimed liquid esters. These species reads on the claimed esters wherein R1 is tertiary butyl group and R2 is tridecyl or isostearyl group. See col.2, lines 61-63 for the range of claimed adjuvant, which is also the claimed cationic polymers and see col.4, lines 34-35 for the claimed quaternary

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cellulose ether derivatives. See col.16, lines 13 for claimed adjuvants, which are silicones and vitamins. The patent teaches various oils as conditioning agents.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '763 and increase the surfactant the emollient taught by '017 expecting beneficial effect. One of ordinary skill in the art would be motivated to use higher concentration of surfactant with the reasonable expectation of success that surfactants are used for cleansing properties and the presence of isostearyl neopentanoate in the compositions provide emolliency. This is a prima facie case of obviousness.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

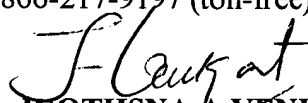
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is

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571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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